

REMARKS

This Application has been carefully reviewed in light of the Office Action transmitted September 4, 2007 (the "Office Action"). At the time of the Office Action, Claims 1-20 were pending in the application. The Office Action rejects Claims 1-20. Applicants respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,598,187 to Ide ("Ide") in view of WO 01/86920 to Lapidot ("Lapidot"). Applicants respectfully traverse these rejections.

The Office Action states that Ide does not disclose a handheld device comprising a display but that *Lapidot* teaches a handheld device "with a display screen for controlling the information presented in its display." Office Action, page 4. The Office Action then states:

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the motion controlled handheld device of Ide to have a display as taught by Lapidot so as to provide a small handheld device for conveniently controlling the function of the handheld device and the presentation of information in the display of the device.

Id. Applicants respectfully submit that the combination of *Ide* and *Ishida* proposed by the Examiner is improper because it would not be obvious to combine *Ide* and *Ishida* in the manner the Examiner proposes.

To establish a *prima facie* case of obviousness, the references must teach or suggest all elements of the rejected claims and it must have been obvious to one of ordinary skill in the art at the time of invention to combine or modify the references. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, No. 04-1350 (2007); *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In *KSR Int'l Co. v. Teleflex Inc.*, the Supreme Court clarified the appropriate standard to use when determining obviousness. 550 U.S. ___, No. 04-1350 (2007). "The [obviousness] analysis is objective: 'Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained;

and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined." *Id.* (citing *Graham v. John Deere*, 383 U.S. 1, 17-18, 148 U.S.P.Q. 459 (1966)).

A "principal reason for declining to allow patents for what is obvious" is to prevent individuals from obtaining a patent "for a combination which only unites old elements with no change in their respective functions." *Id.* However, the Supreme Court clarified that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* "[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* While not a rigid test, a showing of a "teaching, suggestion, or motivation" to combine or modify prior art provides helpful insight in determining whether it would have been obvious to combine references. *Id.* "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." *Id.* (citing *Graham*, 383 U.S. at 36).

The new examination guidelines issued by the United States Patent and Trademark Office ("PTO") in response to the *KSR* decision further emphasize the importance of an explicit, articulated reason why the claimed invention is obvious. Those guidelines state, in part, that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528-29 (Oct. 10, 2007) (internal citations omitted). The guidelines further describe a number of rationales that, in the PTO's view, can support a finding of obviousness. *Id.* at 57529-34. The guidelines set forth a number of particular findings of fact that must be made and explained by the Examiner to support a finding of obviousness based on one of those rationales. *See id.*

Furthermore, the M.P.E.P. explicitly states, “[i]f [the] proposed modification would render the prior art invention being modified *unsatisfactory for its intended purpose*, then there is *no suggestion or motivation to make the proposed modification.*” M.P.E.P. § 2143.03, *citing In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) (emphasis added); *see also KSR*, 127 S.Ct at 1739 (when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious).

The Examiner suggestion that it would have been obvious to modify the device of *Ide* to have a display "so as to provide a small handheld device for conveniently controlling the function of the handheld device and the presentation of information in the display of the device" to purportedly arrive at Applicants invention is entirely insufficient to support a *prima facie* case of obviousness under 35 U.S.C. 103(a) under the M.P.E.P. and the governing Federal Circuit case law. "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ___, No. 04-1350 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Ide clearly teaches away from any combination that places a display of the device of *Ide*. *Ide* refers to its input device as a "spatial control mouse" and repeatedly thereafter as a "mouse." A conventional mouse (for example, the well-known ball mouse or optical mouse used with a personal computer) does not include a built-in display. A mouse is typically used to move a cursor on a screen. As *Ide* states, "the operator moves the mouse on the desk to move the cursor interlocking with the mouse movement to the desired object . . . appearing on the display. With the cursor positioned over the desired object on the display, he clicks (or releases) an acknowledge switch called a click button of the mouse to enter data to the system." *Ide*, col. 1, lines 21-28. Thus, when using the mouse, the user watches the screen to track the movement of the cursor while the user's hand is on the mouse. There is therefore no motivation to put a viewable display on the mouse because the user rarely has reason to look away from the screen and toward the mouse while using the mouse. Using a three-dimensional input device as described by *Ide* is similar. *Ide* says, "[t]he operator moves the

three-dimensional input device in space to move the cursor interlocking with the movement of the input device to the desired object on the screen." *Ide*, col. 1, lines 52-58. Further, the user's hand covers the majority of the surface of a mouse, so any viewable display on the mouse would be largely blocked from the user's view while the user was operating the mouse. Because of these well-known attributes of its use, there is no motivation to include a viewable display on an input device as described by *Ide*, and the cited references teach away from such a combination.

Accordingly, since there is no motivation to make the proposed combination and since the prior art teaches away from the proposed combination, it would not be obvious to combine *Ide* with *Ishida* in the manner the Examiner proposes. Applicants respectfully submit that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness.

Therefore, for at least these reasons, Applicants respectfully submit that Claims 1, 10, 16, and 20 are patentable over the cited art used in the rejections and request withdrawal of these rejections.

Claims 2-9 each depends from Claim 1, Claims 11-15 each depends from Claim 10, and Claims 17-19 each depends from Claim 16. Thus, for at least the reasons discussed above with respect to Claims 1, 10, and 16, Applicants respectfully request withdrawal of the rejections of Claims 2-9, 11-15, and 17-19.

Claims 3 and 12

In addition, Claim 3 (which depends from Claim 2) recites that the mode selection trigger comprises a change in a state of the device and that "the change in the state of the device occurs when the device switches from a first application to a second application." Claim 12 recites similar elements. The Office Action merely cites to Figure 1 and Figure 16 of *Ide* as disclosing these elements. However, neither these figures, their related description, nor any other portion of *Ide* discloses that a switch from a first application to a second

application is a mode selection trigger that triggers the switch between the first mode of motion input operation and the second mode of motion input operation. *Ide* only discloses that the switching between its pointer function and motion pattern input function "may be set on the mouse side or specified on the control target device side" or by pressing a "motion input start button." *Ide*, col. 15, lines 39-42 and col. 22, lines 28-32. There is no disclosure that a switch from a first application to a second application triggers the change in motion input modes. Therefore, for at least this additional reason, Applicants respectfully submit that Claims 3 and 12 are patentable over the cited art used in the rejections and request that the rejections of these claims be withdrawn.

Claims 4 and 13

In addition, Claim 4 (which depends from Claim 2) recites that the mode selection trigger comprises a change in a state of the device and that "the change in the state of the device occurs when the current image switches from a first image to a second image." Claim 13 recites similar elements. As indicated above, in the discussion of Claims 3 and 12, *Ide* only discloses that the switching between its pointer function and motion pattern input function may be set on the mouse side or specified on the control target device side or by pressing a motion input start button. *See Ide*, col. 15, lines 39-42 and col. 22, lines 28-32. There is no disclosure that a switch from a first image to a second image triggers the change in motion input modes. Therefore, for at least this additional reason, Applicants respectfully submit that Claims 4 and 13 are patentable over the cited art used in the rejections and request that the rejections of these claims be withdrawn.

Claim 6

In addition, Claim 6 recites that the mode selection trigger comprises one of the gestures. The Office Action cites to column 22, lines 31-32 of *Ide* as disclosing this element. *See* Office Action, page 4. However, this cited portion merely discloses the operation of changing from a pointer function to a motion input function as placing the cursor in a certain position, pressing a motion input start button, and making predetermined simple movements such as waving up and down several times. *See Ide*, col. 22, lines 28-32. There is no disclosure of an actual gesture for triggering a switch in motion input modes. Therefore, for

at least this additional reason, Applicants respectfully submit that Claim 6 is patentable over the cited art used in the rejections and request that the rejection of this claim be withdrawn.

Claim 8

Moreover, Claim 8 recites that the display control module has a third mode of operation "to disregard the motion of the device." The Office Action cites to portions of *Lapidot* as disclosing this element. *See* Office Action, page 5. However, to make the rejection of Claim 1, the Office Action relies on modifying *Ide* to place a display on the handheld device of *Ide*. *Ide* is solely directed to a "spatial control mouse" to control a cursor on, for example, a laptop or to control another device through motion. Having a mode of operation that disregards motion of the spatial control mouse of *Ide* clearly teaches away from *Ide*'s disclosure and would make *Ide* unsatisfactory for its intended purpose, which is to control equipment through motion input. Therefore, for at least this additional reason, Applicants respectfully submit that Claim 8 is patentable over the cited art used in the rejections and request that the rejection of this claim be withdrawn.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad C. Walters, Attorney for Applicants, at the Examiner's convenience at (214) 953-6511.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any other fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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